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REMARKS

Applicants respectfully request reconsideration in view of the above amendments and the following remarks. Claims 1, 9, 16 and 25 have been amended. Applicants do not add or cancel any claims. Accordingly, claims 1-30 remain pending in the application.

I. **Claim Amendments**

Claims 1, 9, 16 and 25 have been amended to correct minor grammatical errors. Entry of the amendments is respectfully requested.

II. **Claims Rejected Under 35 U.S.C. § 103(a)**

Claims 1-30 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent Application No. 2002/0143434 issued to Greeven et al ("Greeven") in view of U.S. Patent Application No. 2002/0052760 issued to Munoz et al. ("Munoz") and further in view of U.S. Patent Application No. 2003/0065626 issued to Allen ("Allen"). Applicants respectfully traverse the rejection.

To establish a *prima facie* case of obviousness, the references relied upon must teach or suggest every limitation of the claim such that the invention as a whole would have been obvious at the time the invention was made to one skilled in the art. Claim 1 includes "receiving the renewal request from the benefits management site . . . , the renewal request including prescription-related information added by the benefits management site." Applicants submit that Greeven in view of Munoz and further in view of Allen does not teach or suggest these elements of claim 1.

The claim must be considered as a whole, since "the question under 35 U.S.C. 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious" (MPEP 2141.02, citing *Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530 (Fed. Cir. 1983); *Schenck v. Nortron Corp.*, 713 F.2d 782 (Fed. Cir. 1983)). Examiner admits that neither Greeven nor Munoz teaches "receiving the renewal request from the benefits management site . . . , the renewal request including prescription-related information added by the benefits management site," but asserts that Allen suggests a method having "a, transmitting," "from," "to a benefits management site," "receiving the renewal request," "the," "management site," "added by the benefits management site" (Office Action, Oct. 19, 2006).

042390.P11782   7   10/039.120

PAGE 11/13 * RCVD AT 12/18/2006 6:00:21 PM [Eastern Standard Time] * SVR:USPTO-EFXRF-6/37 * DNIS:2738300 * CSID:3108205988 * DURATION (mm-ss):02-16

Applicants respectfully submit that it is improper to reject a claim for obviousness by viewing its elements in regard to the prior art in such a piecemeal fashion.

Allen teaches the use of a portable healthcare device to facilitate health-related transactions with remote sites (Para. 0018). Such transactions may include sending renewal prescriptions from the portable healthcare device to a pharmacy site, or submitting claims via the portable healthcare device to remote payer sites. Allen does not, however, teach a renewal request being received from a benefit management site which adds prescription-related information to the renewal request. Thus, the cited references, separately or combined, do not teach or suggest each of the elements of claim 1 considered as a whole.

Moreover, Allen focuses on the routing of transactions via a portable healthcare device and the convenience to the user of the portable healthcare device (Para. 0002, 0015-0018). In fact, Examiner states the motivation for combining Allen with Greeven and Munoz to be that of "providing handheld devices in conducting health-related transactions that involve exchanges of electronic information across a network." Although the use of a portable healthcare device is recited in claim 1, Examiner has not provided motivation for modifying Greeven and Munoz for "receiving the renewal request from the benefits management site . . . , the renewal request including prescription-related information added by the benefits management site" (emphasis added). As described in the present application, routing the renewal request through a benefits management site allows a healthcare professional to receive in real time not only the renewal request as initially submitted from the pharmacy site, but also the information added by the benefits management site (Application, Para. 0018, 0019). This information may aid the healthcare professional in making an informed decision in real time. Applicants are unable to discern such teaching in any part of Allen. However, Examiner has not established motivation to add this feature to Greeven in view of Munoz. Hence, claim 1 is not obvious over Greeven in view of Munoz and further in view of Allen.

Analogous discussions apply to claims 9, 16 and 25, which include elements similar to those discussed above in regard to claim 1. Claims 2-8, 10-15, 17-24 and 26-30 respectively depend from claims 1, 9, 16 and 25 and incorporate the limitations thereof. Thus, for at least the reasons mentioned above, Greeven in view of Munoz in view of Allen does not teach or suggest each of the elements of these dependent claims. Accordingly, reconsideration and withdrawal of the obviousness rejection of claims 1-30 are requested.

042390.P11782   8   10/039,120

PAGE 12/13 * RCVD AT 12/18/2006 6:00:21 PM [Eastern Standard Time] * SVR:USPTO-EFXRF-6/37 * DNIS:2738300 * CSID:3108205988 * DURATION (mm-ss):02-16

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CONCLUSION

In view of the foregoing, it is believed that all claims are now in condition for allowance and such action is earnestly solicited at the earliest possible date. If there are any additional fees due in connection with the filing of this response, please charge those fees to our Deposit Account No. 02-2666.

Respectfully submitted,

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Dated: December 18, 2006

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I hereby certify that this correspondence is being transmitted via facsimile to (571) 273-8300 on the date below addressed to: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

Annie McNally   12/18/2006
                                        Date

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